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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/128,753 08/04/98 LIGHTCAP,

D DVL-003PAT

EXAMINER

HM12/0729

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PRYOR, A

ART UNIT

PAPER NUMBER

1616

DATE MAILED:

07/29/99

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.  
**09/128,753**

Applicant(s)  
**Lightcap et al**

Examiner  
**Alton Pryor**

Group Art Unit  
**1616**



☒ Responsive to communication(s) filed on Sep 14, 1998

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 1-35 is/are pending in the application.

Of the above, claim(s) 4, 5, 7, 9-24, 28-32, 34, and 35 is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 1-3, 6, 8, and 25-27 is/are rejected.

☒ Claim(s) 33 is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been  
☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 2

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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### **Restriction Requirement**

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-33,35, drawn to compositions and methods, classified in class 504, subclass 350.
- II. Claim 34, drawn to apparatus, classified in class 239, subclass 40+.

Inventions I and II are distinct. The search for invention I differs from the search required for invention II. Because these inventions are distinct for the reason given above and have acquired a separate status in the art as shown by their different classification restriction for examination purposes as indicated is proper.

During a telephone conversation with Mr. Mark Smith on 7/25/99 a provisional election was made with traverse to prosecute the invention of group I, claims 1-33,35. Affirmation of this election must be made by applicant in replying to this Office action. Claim 34 is withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

### **Election Requirement**

This application contains claims directed to the following patentably distinct species of the claimed invention: Numerous compositions.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held

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to be allowable. Currently, a composition comprising a vegetable oil, an emulsifier, and a foaming agent is generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

During a telephone conversation with Mr. Mark Smith on 7/25/99 a provisional election was made with traverse to prosecute the invention of a composition comprising soy oil, ethylene oxide, and alkyl sulfate, claims 1-3,6,8,25-27,33. Affirmation of this election must be made by applicant in replying to this Office action. Claims 4,5,7,9-24,28-32,35 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

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### **First Action on the Merits**

#### ***Action Summary***

Claims 1-35 are pending. Claims 1-3,6,8,25-27 are rejected. Claim 33 is objected to.

Claims 4,5,7,9-24,28-32,35 are withdrawn from consideration.

#### ***Claim Rejection under 35 U.S.C. 112, 2nd paragraph***

Claim 26 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The term "ethylene" in claim 26 line 1 is unclear to the examiner. The examiner assumes that the applicants made a spelling error. The examiner assumes that the term should be "ethylene". Correct if necessary.

#### ***Claim Rejections under 35 U.S.C. 103(a)***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3,6,8,25,27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Thiel et al (US 5,344,643) and Roe et al (US 5,500,220). Thiel teaches a composition comprising vegetable oil (soy oil), alkyl sulfate, ethylene oxide, and water. See claim 1. The reference does not teach that the alkyl sulfate is a foaming agent. Roe teaches that alkyl sulfates function as foaming agents. See column 3 lines 16-18. One having ordinary skill in the art would have been

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motivated to use to the instant composition as a foam since the prior art teaches that the combination of said ingredients create a foam. Hence, the references make obvious the instant invention. The instant percent emulsifier is not taught by the prior art. However, one having ordinary skill in the art would have been motivated to determine the optimum % emulsifier because one would have been expected to make the best foam producing composition.

Claims 1-3,8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Inoue et al (US 4,127,654) and Roe et al (US 5,500,220). Inoue discloses a composition comprising vegetable oil, alkyl sulfate, ethylene oxide, and water. See column 5 lines 15-30. The reference does not teach that the alkyl sulfate is a foaming agent. Roe teaches that alkyl sulfates function as foaming agents. See column 3 lines 16-18. One having ordinary skill in the art would have been motivated to use to the instant composition as a foam since the prior art teaches that the combination of said ingredients create a foam. In addition, the references does not disclose that ethylene oxide is an emulsifier. However, one of ordinary skill in the art would know that ethylene oxide can serve as an emulsifier. Hence, the references make obvious the instant invention.

Claims 1-3,8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wdowik (US 5,756,081). The reference teaches a composition comprising coconut oil, surfactant, water, and foaming agent. See column 1 lines 35-50. The reference does not state that coconut oil and surfactant are vegetable oil and emulsifier, respectively. However, one having ordinary skill in the art would know that coconut is a vegetable oil and a surfactant can serve as an emulsifier. Hence, the reference makes obvious the instant invention.

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***Claim Objection***

Claim 33 objected to as containing non-elected subject matter, but would be allowable if rewritten in independent form excluding non-elected subject matter. The prior art does not teach the elected composition being used in a method of protecting plants from frost or freezing temperatures.

***Telephonic Inquiries***

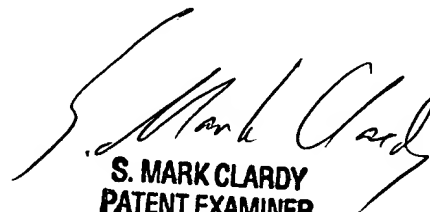
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alton Pryor whose telephone number is (703) 308-4691. The examiner can normally be reached on Monday through Friday from 8:00 a.m. to 4:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jose Dees, can be reached on (703) 308-4628. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-4556.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.

ANP

7/25/99

  
**S. MARK CLARDY  
PATENT EXAMINER  
GROUP 1200-1616**